

REMARKS:

In the foregoing amendments, claims 4-6 were canceled and replaced with new claims 7-9. Claims 7-9 are the only claims pending in the application at this time.

Also in the foregoing amendments, applicant's specification was amended above to remove alleged new matter as identified in the outstanding Office action. Still further, applicant's specification was amended to include a new Fig. 2C, which will be discussed below. A description of this new figure was also included in applicant's specification.

The Official action objected to the amendment filed on August 8, 2001, together with the application, under 35 U.S.C. § 132 because it introduces new matter into the disclosure. The Official action required that the applicants cancel the alleged new matter in reply to the outstanding Office action. The position in the outstanding Office action that the preliminary amendment filed on August 8, 2001, introduces new matter into the application is the basis for many other objections and rejections as set forth in the outstanding Office action. These include an objection to the specification for failing to provide proper antecedent basis for the claimed subject matter, namely, the term "sealing member" that appears in the claims, which is set forth in section 9 on page 5 of the Official action. In response to the new matter objection, applicant is attaching hereto a substitute declaration signed by all of the inventors

identifying the present application by its serial number as amended with the preliminary amendment on August 8, 2001. This declaration corrects a formal matter in identifying the preliminary amendment filed on August 8, 2001, as part of the present application. For this reason, applicant respectfully requests that the examiner reconsider and withdraw the objection to the preliminary amendment filed on August 8, 2001, as containing new matter.

In this connection, attention is respectfully directed to the Manual of Patent Examining Procedure (MPEP) § 608.04(b). In the first paragraph of this section of the MPEP, it is stated that an amendment is sometimes filed along with the filing of an application and where a 37 C.F.R. § 1.53(b) application (such as the present application) is filed without a signed oath or declaration and such an application is accompanied by an amendment, that amendment is considered a part of the original disclosure (emphasis added). This section of the MPEP continues that the subsequently filed oath or declaration must refer to both the application and the amendment, which the attached substitute declaration does.

This portion of the MPEP states that the presumption is that an amendment filed together with the application and without a signed oath or declaration is a part of the original disclosure and that the subsequent filing of the oath or declaration must refer to both the application and the amendment is a formal matter. For such reasons, applicant respectfully

submits that the amendment filed on August 8, 2001, together with the application, is part of the application and not new matter. In other words, as a matter of law and U.S. patent practice, an amendment filed together with an application, which application is filed without an executed oath or declaration, is considered a part of the application. Therefore, such a preliminary amendment cannot be regarded as new matter. For these reasons, applicant respectfully requests that the examiner reconsider and withdraw the objection to the preliminary amendment filed on August 8, 2001, as containing new matter.

In the event the aforesaid new matter objection is not removed, applicant hereby reserves the right to petition that Commissioner.

The Official action included an objection to the amendment filed on March 7, 2002, as containing new matter. The Official action stated that the expression "the cooling water flowing in the cooling water passage" may "be always renewed by a new one or may be circulated with the outside" is new matter. However, applicant respectfully notes that the original text of this application on page 7, lines 14-22, describes the cooling water may be always renewed by new one or may be circulated with the outside. Accordingly, this expression objected to as new matter is contained elsewhere in applicant's original specification disclosure, and therefore, is not new matter.

In this new matter objection, an objection was made to the amendments concerning the length of the connecting pipe. In this

connection, in the foregoing amendments, page 10 of applicant's specification disclosure was amended by returning this portion of applicant's specification to the text submitted together with the application filed on August 8, 2001, which included the preliminary amendment filed together with the application.

For the foregoing reasons, applicant respectfully submits that the present application contains no new matter. Therefore, applicant respectfully requests that the examiner reconsider and withdraw this and all objections to the specification as containing new matter.

The Official action objected to the declaration and requested a new declaration. Applicant is attaching a substitute declaration hereto. Therefore, applicant respectfully requests that the examiner reconsider and withdraw the objection to the declaration.

The Official action objected to Fig. 3 because it should contain a legend "Prior Art." In addition, the Official action stated that the drawing must show every feature of the invention as specified in the claims. The Official action continued at the length of the connecting pipe and the width of the sealing member as set forth in claims 4 and 5, and the respective lengths of the first and second connecting members and respective widths of each of the first and second sealing members as recited in claim 6, is not shown in the drawings.

Applicant is submitting a transmittal of drawings together with this response. Together with the transmittal of drawings is a

replacement Fig. 3 and a new Fig. 2C. In the replacement figure, the legend "Prior Art" was inserted on Fig. 3. New Fig. 2C corresponds to the bottom lower right-hand portion of Fig. 2B that was enlarged to better show the dimensions of the parts therein. The parts of Fig. 2C are identified by the same legends used in Fig. 2B. In addition, the legends L1, L2, L3, and W were included on Fig. 2C to identify the various lengths and width as set forth in applicant's specification and claims including the original claims. Applicant's specification was amended to identify these legends. In Fig. 2C, L1 is the first distance, as set forth in applicant's claims, which is the distance from the first block 16 to the temperature controlling heat-exchanger 11. L2 is the second distance from the relay block (or second block) 15 to the temperature controlling heat-exchanger 11, as set forth in claim 7. W is the width of the sealing member. L3 is the length of the connecting pipe 21. These lengths have the following relationship:  $(L2 + W) < L3 \leq L1$ . In other words, as set forth in the present claims, the length of the connecting pipe L3 is less than or equal to the first distance between the first block 16 and the temperature controlling heat-exchanger 11 (L1); and the length of the connecting pipe L3 is greater than the sum of (1) the distance L2 between the second or relay block 15 and the temperature controlling heat-exchanger 11 (L2) and (2) the width of the sealing member (W). In light of the proposed new figure 2C and corrected figure 3, applicant

respectfully request that the examiner reconsider and withdraw the objections to the drawings as set forth in the outstanding Office action.

In the foregoing amendments, the abstract of the disclosure was amended to correct grammatical and idiomatic informalities, such as those noted in the outstanding Office action. Therefore, applicant respectfully requests that the examiner reconsider and withdraw the objection to the abstract of the disclosure as set forth in the outstanding Office action.

The Official action objected to the specification as not providing proper antecedent basis for the claimed subject matter (sealing member). Applicant respectfully submits that the amendment filed together with the application on August 8, 2001, in the amendment to the paragraph beginning at page 7, line 14, includes the expression "sealing member 14." Since this preliminary amendment is not new matter, as explained above, applicant's specification describes the sealing member as set forth in the claims. For these reasons, applicant respectfully requests that the examiner reconsider and withdraw the objections to the specification.

The Official action included an objection to claim 4. Since claim 4 was canceled above, this objection is now moot. It is respectfully noted that proper antecedent basis was provided for all the elements defined in new claims 7-9.

Claims 4-6 were rejected under 35 U.S.C. § 112, first paragraph, for reasons identified in the paragraph bridging pages 5 and 6 of the

Official action. This rejection is based upon the amendments to the applicant's specification, namely those filed on August 8, 2001, as being new matter. However, since this amendment is not new matter as explained above with reference to the MPEP, applicant respectfully submits that any portion of this rejection made under the first paragraph of 35 U.S.C. § 112 based on new matter be reconsidered and withdrawn.

The rejection under the first paragraph of 35 U.S.C. § 112, continued that the specification failed to define the standard for ascertaining what range of values corresponds to the term "slightly shorter" as used in claims 4-6. Claims 4-6 were also rejected under 35 U.S.C. § 112, second paragraph, due to the term "slightly shorter" as being indefinite. As explained above, claims 4-6 were canceled from the application. New claims 7-9 do not contain the expression "slightly shorter." Therefore, applicant respectfully submits that these portions of the rejection under 35 U.S.C. § 112, first and second paragraphs, are now moot.

The Official continued that it is not clear what is encompassed by "a width of the sealing member" as recited in claims 4 and 5, nor what is encompassed by "a distance between said temperature controlling heat-exchanger and said first block" as also recited in claims 4 and 5. The Official action stated that claim 6 contains similar language.

Applicant respectfully submits that it is very common in U.S. patent practice to define a width or a distance or a length of a structure,

which simply mean the width, the distance, or the length of the corresponding structure. Accordingly, this portion of the rejection under 35 U.S.C. § 112, second paragraph, is not understood.

In any event, in claims 7-9, which were added above, the expressions objected to in the outstanding Office action were not included.

Applicant respectfully submits that new claims 7-9 are in compliance with the first and second paragraphs of 35 U.S.C. § 112. Therefore, applicant respectfully requests that the examiner reconsider and withdraw any objections or rejections based upon these provisions of 35 U.S.C. § 112.

Claims 4-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. patent No. 3,324,942 of Miller. The Official action stated that Miller discloses in Fig. 3: a connecting pipe corresponding to any one of tube 3' or a portion thereof; a first block 18 or 26'; a second block 10; and, a sealing member or O-ring 14. The Official action continued that 3' are disposed in a temperature controlling heat-exchanger.

Applicant respectfully submits that the teachings of Miller do not contemplate or suggest the invention as set forth in claims 7-9 within the meaning of 35 U.S.C. §§ 102 or 103.

Applicant's claims all define a first block that is arranged at a first distance from the temperature controlling heat-exchanger. Applicant



cannot find within the teachings of Miller any structure corresponding to a first block arranged at a first distance from the heat temperature controlling heat-exchanger, as required in the present claims.

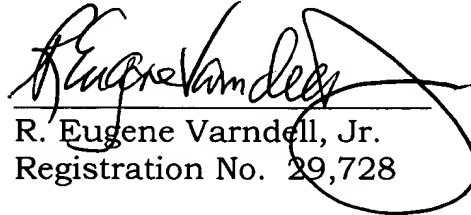
Applicant's claims define a second block arranged at a second distance from the temperature controlling heat-exchanger. Applicant cannot find within the teachings of Miller any structure corresponding to a second block arranged at a second distance from the heat temperature controlling heat-exchanger, as required in the present claims.

Applicant's claims define connecting pipes having a length equal or slightly shorter than the first distance but longer than the second distance and the width of the sealing member. The teachings of Miller simply do not contemplate or suggest a connecting pipe having such a length or an arrangement of connecting pipes relative to first and second blocks as required in the present claims. Therefore, applicant respectfully submits that the presently claimed invention is distinguishable from the teachings of Miller. Therefore, applicant respectfully requests that the examiner reconsider and withdraw this rejection.

In view of the foregoing amendments and remarks, favorable consideration and a formal allowance of claims 7-9 are respectfully requested. While it is believed that the present response places the application in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned

be telephoned at the below listed number to resolved any outstanding issues.

Respectfully submitted,  
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Attachment:  
Executed Substitute Declaration for Patent Application